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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,783	12/30/1999	DONALD K. NEWELL	2207/6929	2707

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EXAMINER	
NALEVANKO, CHRISTOPHER R	
ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 08/12/2004

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/474,783	NEWELL ET AL.	
	Examiner	Art Unit	
	Christopher R Nalevanko	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 7, and 19 have been considered but are moot in view of the new ground(s) of rejection.

2. Applicant's arguments with respect to disagreeing to the Examiner's Official Notice statement regarding the embedded control information have been considered but are moot in view of the new ground(s) of rejection. The Examiner has provided and relied up the cited Horton et al reference to support the statement of Official Notice.

3. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo in further view of Horton et al.

Regarding Claim 1, Russo shows a system for controlling use of broadcast content comprising a receiver in communications with a source of broadcast content and a playback device, wherein the receiver is configured to control the use of the received broadcast content through the playback device in accordance with control information in the received broadcast content (col. 3 lines 3-28 and 50-60, col. 6 lines 12-25, col. 8 lines 55-67, see figure 2). Furthermore, the authorization key and compression algorithms directly define actions or operations to be taken pertaining the broadcast data. Although Russo shows that the control information is in the broadcast content stream (col. 8 lines 65-67, col. 9 line 1), he fails to specifically state that this control information is embedded in the content. Russo also fails to show that the control information defines the action to store the received broadcast content or reproduce the received broadcast content. Horton shows broadcasting audio visual content along with embedded control information to define an action to be taken pertaining to the received content, specifically storing the received broadcast content (col. 3 lines 38-67, 'coded information embedded in the TV signal,' 'indication...of various modes available with this particular program'). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify Russo with the ability to specify the action as storing the content and embedding control information as in Horton in order for the broadcast provider to specify what could be done to the broadcast programs. This could help prevent unauthorized copying and also allow the user to only access certain programs.

Regarding Claim 2, Russo shows that a storage device is couple to the receiver (col. 3 lines 3-20, see figure 1 item 14 'program storage').

Regarding Claim 3, Horton shows that the receiver can store broadcast content in the storage devise based on the control information (col. 3 lines 38-67, 'coded information embedded in the TV signal,' 'indication...of various modes available with this particular program,' 'view and tape for fee, view and tape for free').

Regarding Claim 4, Russo further shows that the receiver is configured to maintain information relating to the use of the received broadcast content (col. 3 lines 20-25, col. 5 lines 48-65).

Regarding Claim 5, Russo shows that the receiver is configured to use the information relating to the use of the received broadcast content for remuneration of a provider of content (col. 4 lines 45-67, col. 5 lines 20-33, col. 6 lines 34-55).

Regarding Claim 6, Russo shows that the information relating to the use of the received broadcast content comprises a duration of use (col. 5 lines 32-47).

Regarding Claim 7, Russo shows a method for controlling the use of broadcast content comprising receiving broadcast content, extracting control information from the received broadcast content (col. 6 lines 12-32, col. 8 lines

55-67), and controlling the use of the received broadcast content in accordance with the extracted control information (col. 6 lines 12-32, col. 9 lines 48-67, col. 5 lines 34-60, col. 4 lines 45-67). Furthermore, the authorization key and compression algorithms directly define actions or operations to be taken pertaining the broadcast data. Although Russo shows that the control information is in the broadcast content stream (col. 8 lines 65-67, col. 9 line 1), he fails to specifically state that this control information is embedded in the content. Russo also fails to show that the control information defines the action to store the received broadcast content or reproduce the received broadcast content. Horton shows broadcasting audio visual content along with embedded control information to define an action to be taken pertaining to the received content, specifically storing the received broadcast content (col. 3 lines 38-67, 'coded information embedded in the TV signal,' 'indication...of various modes available with this particular program'). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo with the ability to specify the action as storing the content and embedding control information as in Horton in order for the broadcast provider to specify what could be done to the broadcast programs. This could help prevent unauthorized copying and also allow the user to only access certain programs.

Regarding Claim 8, Horton teaches a code that is sent to the receiver that indicates whether a program may be stored or not (col. 2 lines 30-38, col. 3 lines 38-67, 'coded information embedded in the TV signal,' 'indication...of various

modes available with this particular program,' 'view and tape for fee, view and tape for free').

Regarding Claim 9, Russo does show lengths of time and days that the broadcast may be viewed (col.5 lines 33-48). Russo fails to show that the control information indicates the number of times the received broadcast content may be consumed. Limiting the number of times is a logical variation of the restriction of viewing already set forth by Russo and therefore would have been obvious to one of ordinary skill in the art at the time the invention was made. This would enable the broadcast facility to supply the viewer with various pricing and viewing options.

Regarding Claim 10, Russo shows that control information indicates a length of time that the received broadcast content may be consumed (col. 5, lines 32-46).

Regarding Claim 11, Russo shows that control information indicates a time period during which the received broadcast content may be consumed (col. 5, lines 32-46).

Regarding Claim 12, Russo shows that the video can be saved for a predetermined length of time but doesn't specifically state a date range (col. 5, lines 32-46). It is nonetheless inherent that this time period would be more then one day, thus covering a range of dates.

Regarding Claim13, it is inherent that the information sent to the user site would include billing information (col. 6 lines 10-27).

Regarding Claim 14, it is inherent that the information sent to the user site would contain information for the cost of consuming the broadcast (col. 6 lines 10-27).

Regarding Claim 15, Russo shows the ability to "unlock" certain viewing options with a code sent along with the video stream (col. 6 lines 10-27). This inherently prevents the unjustified use of the broadcast material since other options would remain locked.

Regarding Claim 16, Russo shows obtaining payment information from the user (col. 6 lines 20-28, lines 35-46, col. 10 lines 10-48).

Regarding Claim 17, Russo shows communicating consumption information to a billing facility (col. 6 lines 34-53, col. 10 lines 10-48).

Regarding Claim 18, Russo shows that the billing facility comprises a facility maintained by a provider of the broadcast content (col. 6 lines 20-36).

Regarding Claim 19, Russo shows a storage medium containing a set of instructions for execution by a computer (see figure 2 items 136, 156, 150, 158). This clearly shows that the invention of Russo is capable of being carried out by a computer controlled medium. All further limitations of the Claim have been addressed in Claim 7.

Regarding Claim 20, it is further understood that the memory shown in Russo is accessible by a computer.

Regarding Claim 21, Russo fails to show that the storage medium comprises a portable storage device. Official Notice is taken that it is well known and expected in the art to use removable storage devices, such as CD-ROMs or

removable hard drives. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Russo with a portable storage device so that the instructions could be transported to other systems.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Menand et al U.S. Patent No. 5,563,648 discloses a method for controlling execution of an audio video interactive program.

Vogel U.S. Patent No. 4,930,158 discloses selective video playing system.

Chen et al U.S. Patent No. 5,767,893 discloses a method and apparatus for content based downloading of video programs.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R Nalevanko whose telephone number is 703-305-8093. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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